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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,373	01/21/2000	Edward J. Koplar	55121-88011	5751

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EXAMINER	
SALTARELLI, DOMINIC D	
ART UNIT	PAPER NUMBER
2611	

DATE MAILED: 11/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/489,373	KOPLAR ET AL.	
	Examiner	Art Unit	
	Dominic D. Saltarelli	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 October 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *76-86,98,99,104,108,110,114,115,118 and 129-132* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *76-86,98,99,104,108,110,114,115,118 and 129-132* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 3, 2005 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 81 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. On line 22, the claimed limitation of "promotional opportunities of a greater value of redemption" is indefinite because it is unclear as to what value of redemption the promotional opportunities are greater than. For example, when a second promotional opportunity is received having a greater value of redemption than a first promotional opportunity, it is unclear what the value of the first received promotional opportunity is greater than. The examiner's best understanding of this limitation is that each successive promotional opportunity after the first is consequently of greater value than the previously received promotional opportunity.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 76, 77, 98, 104, 108, 110, 114, and 118 rejected under 35 U.S.C. 103(a) as being unpatentable over Nemirofsky (5,594,493) in view of Bullock et al. (5,070,404, of record) [Bullock] and Jernigan et al. (5,233,423) [Jernigan].

Regarding claims 76 and 98, Nemirofsky discloses a hand-held device (figs. 5-8) providing promotional opportunities (col. 7, lines 25-49), the hand-held device comprising a receiver (fig. 5, photodetector 70) disposed on the hand-held device for receiving data from a source (Light from TV screen, fig. 5) and a central processing unit (fig. 5, microprocessor 26), wherein the promotional opportunities are redeemable at a point of sale (col. 11 line 66 – col. 12 line 17). Nemirofsky also discloses providing a display device for a viewer of an event (fig. 1, TV 3).

Nemirofsky fails to disclose circuitry having nonrewritable preprogrammed data embedded thereon by a sponsor prior to providing the hand-held device to a user, the receiver receives auxiliary data associated with the promotional opportunities of the sponsor while the viewer views the display device, and the CPU compares the auxiliary data against the nonrewritable embedded preprogrammed data and triggers promotional opportunities based on the

comparison of the auxiliary data against the nonrewritable embedded preprogrammed data.

In an analogous art, Bullock teaches receiving auxiliary data (enabling or cue signal) associated with the promotional opportunities of a sponsor being displayed to a user of a television system, wherein received auxiliary data is compared against stored data to trigger promotional opportunities based on the comparison (col. 2, lines 34-50 and col. 6, lines 11-46), providing the benefit of enabling promotional opportunities to users contemporaneously with advertisements (col. 6, lines 43-46).

It would have been obvious at the time to a person of ordinary skill in the art to modify the hand-held device disclosed by Nemirofsky to include receiving auxiliary data associated with the promotional opportunities of a sponsor being displayed to a user of a television system which is then compared to locally stored data to trigger promotional opportunities based on the comparison, as taught by Bullock, for the benefit of enabling promotional opportunities to users contemporaneously with advertisements, making the advertisements more effective.

Nemirofsky and Bullock fail to disclose the stored data is embodied in circuitry having nonrewritable preprogrammed data embedded thereon by a sponsor prior to providing the hand-held device to a user.

In an analogous art, Jernigan teaches providing promotional opportunities to users which are stored in circuitry, wherein the promotional opportunities are

nonrewritable preprogrammed data embedded thereon by a sponsor prior to providing the device to a user (advertisements, provided by a sponsor, are stored on ROM, col. 2, lines 45-47), wherein ROM storage is not subject to tampering.

It would have been obvious at the time to a person of ordinary skill in the art to modify the hand-held device disclosed by Nemirofsky and Bullock to include providing promotional opportunities to users which are stored in circuitry, wherein the promotional opportunities are nonrewritable preprogrammed data embedded thereon by a sponsor prior to providing the device to a user, as taught by Jernigan, for the benefit of preventing unauthorized tampering of the promotional opportunities.

Regarding claims 77, 104, 108, 114, and 118, Nemirofsky, Bullock, and Jernigan disclose the hand-hand device of claim 76, wherein the source is a display device and the receiver is a photodetector (as shown above in Nemirofsky, the source is TV 3 shown in fig. 1 and the photodetector is photodetector 70 shown in fig. 5).

Regarding claim 110, Nemirofsky, Bullock, and Jernigan disclose the hand-held device of claim 76, and additionally disclose a plurality of lights in a sequenced array operatively associated with the central processing unit and disposed on the hand-held device, the sequenced array capable of notifying the user of one or more matches of the auxiliary data against the nonrewritable

embedded preprogrammed data (Bullock teaches indicator lights associated with the processor light up on receipt of the auxiliary data which activates promotional data, col. 7, lines 47-54).

6. Claims 78-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nemirofsky, Bullock, and Jernigan as applied to claim 76 above, and further in view of Borras et al. (5,301,353) [Borras].

Regarding claims 78-80, Nemirofsky, Bullock, and Jernigan disclose the hand-held device of claim 76, but fail to disclose the source also includes a radio signal source and the receiver also includes a radio frequency receiver.

In an analogous art, Borras teaches a portable device which receives information both from optical sources and RF sources to enhance the usefulness of a portable information receiver (col. 2, lines 4-14).

It would have been obvious at the time to a person of ordinary skill in the art to modify the hand-held device disclosed by Nemirofsky, Bullock, and Jernigan to include a radio signal source and a radio frequency receiver, as taught by Borras, for the benefit of enhancing the usefulness of the hand-held device to flexibly receive both optical and RF signals.

7. Claims 81, 82, 85, 115, 129, and 130 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nemirofsky in view of Bullock and Banasal et al. (6,016,338) [Banasal].

Regarding claims 81, 129, and 130, Nemirosky discloses a hand-held device for providing promotional opportunities (col. 7, lines 25-49) comprising:

A receiver disposed on the hand-held device (fig. 7, lens 70, col. 7, lines 50-62) for successive reception of auxiliary data (benefit or value data) from a source at times scheduled by a sponsor during a single video program or program series (col. 11, lines 30-42);

A memory (fig. 5, RAM 30) operatively associated with the receiver and disposed on the hand-held device for storing the auxiliary data and a successive reward data criteria (each successive benefit or value data received includes redemption criteria for the reward, including expiration dates and redemption locations, col. 11, lines 36-42), wherein the successive reward data criteria requires that user of the hand-held device capture the auxiliary data at the times scheduled by the sponsor during the single video program or program series (the user cannot receive the auxiliary data and corresponding reward data criteria at any time other than when scheduled by the sponsor, col. 11, lines 30-32);

A central processing unit (fig. 5, CPU 20) operatively associated with the memory and the receiver for determining whether the auxiliary data matches the successive reward data criteria (upon retrieval of a benefit for redemption, a comparison is made between the reward criteria and the auxiliary data to determine the availability of said reward and otherwise recall information regarding said reward from memory, such as serial numbers and code words to correct faulty point of purchase scans, col. 11 line 66 – col. 12 line 17).

Nemirofsky fails to disclose a plurality of lights in a sequenced array operatively associated with the central processing unit and disposed on the hand-held device, wherein the plurality of lights are illuminated upon each match of the successive reception of auxiliary data with the successive reward data criteria to visually indicate on the hand held device the availability of promotional opportunities of a greater value for redemption.

In an analogous art, Bullock teaches a plurality of lights in a sequenced array operatively associated with a central processing unit, the sequenced array capable of notifying the user of one or more matches of auxiliary data against preprogrammed data (indicator lights associated with the processor light up to indicate active promotional data, col. 7, lines 47-54, wherein data is regarded as active upon a match between the coupon data and data which indicates that particular coupon is enabled, the 'cue signal', col. 2, lines 34-62), providing the benefit of a visual indication which informs the user of active and redeemable coupons in memory.

It would have been obvious at the time to a person of ordinary skill in the art to modify the hand-held device disclosed by Nemirofsky to include a plurality of lights in a sequenced array operatively associated with the central processing unit, the sequenced array capable of notifying the user of matches of the successive reward data criteria with the auxiliary data, as taught by Bullock, for the benefit of providing a visual indication which informs a user of those coupons which are active and redeemable, for example, coupon data which has not yet

expired would be recognized as such via a comparison of the coupon with its reward data criteria and would illuminate its corresponding light to designate availability.

Nemirofsky and Bullock fail to disclose promotional opportunities of a greater value for redemption.

In an analogous art, Bansal teaches a tiered prize scheme awarded to users (col. 1, lines 35-51 and col. 4, lines 43-57) to encourage users to persistently utilize a service in a manner that benefits the sponsor (such as making calls during certain times of day, col. 1, lines 52-63 or to certain destinations, col. 2, lines 35-48).

It would have been obvious at the time to a person of ordinary skill in the art to modify the hand-held device of Nemirofsky and Bullock to utilize a tiered prize scheme (wherein successive promotional opportunities possess a greater value for redemption), as taught by Bansal, for the benefit of encourage users to persistently utilize the hand-held device in the manner that benefits the sponsor.

Regarding claim 82, Nemirofsky, Bullock, and Bansal disclose the hand-held device of claim 81, wherein the source is a display device and the receiver is a photodetector (Nemirofsky, col. 11, lines 30-35).

Regarding claim 85, Nemirofsky, Bullock, and Bansal disclose the hand-held device of claim 81, wherein the plurality of lights are a plurality of LEDs (Bullock, col. 7, lines 25-34).

Regarding claim 115, Nemirofsky, Bullock, and Bansal disclose the hand-held device of claim 81, wherein the auxiliary data is modulated within a video signal in a substantially invisible way (Nemirofsky, col. 7, lines 25-40).

8. Claims 83 and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nemirofsky, Bullock, and Bansal as applied to claim 81 above, and further in view of Borras.

Regarding claims 83 and 84, Nemirofsky, Bullock, and Bansal disclose the hand-held device of claim 81, but fail to disclose the source also includes a radio signal source and the receiver also includes a radio frequency receiver.

In an analogous art, Borras teaches a portable device which receives information both from optical sources and RF sources to enhance the usefulness of a portable information receiver (col. 2, lines 4-14).

It would have been obvious at the time to a person of ordinary skill in the art to modify the hand-held device disclosed by Nemirofsky, Bullock, and Bansal to include a radio signal source and a radio frequency receiver, as taught by Borras, for the benefit of enhancing the usefulness of the hand-held device to flexibly receive both optical and RF signals.

9. Claim 86 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nemirofsky, Bullock, and Bansal as applied to claim 81 above, and further in view of Brooks et al. (5,483,276, of record) [Brooks].

Regarding claim 86, Nemirofsky, Bullock, and Bansal disclose the hand-held device of claim 81, but fail to disclose the lights are two or more different colors.

In an analogous art, Brooks teaches using a plurality of LEDs of different colors to provide color-coded messages as indicators (col. 8, lines 1-3).

It would have been obvious at the time to a person of ordinary skill in the art to modify the hand-held device of Nemirofsky, Bullock, and Bansal to include lights of different colors, as taught by Brooks, for the benefit of providing color coded indications to distinguish information (i.e. promotional opportunities).

10. Claim 99 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nemirofsky, Bullock, and Jernigan as applied to claim 98 above, and further in view of Boggs et al. (4,789,371, of record) [Boggs].

Regarding claim 99, Nemirofsky, Bullock, and Jernigan disclose the hand-held device of claim 98, but fail to disclose the hand-held device resembles a snap-shot camera.

In an analogous art, Boggs teaches a toy camera that resembles a snap-shot camera (fig. 1) which simulates a real camera (col. 2, lines 41-47) for the

benefit of providing a familiar mechanism to simulate an image pickup device (col. 2, lines 60-68 and col. 4, lines 5-11) to provide entertainment (the device is a toy, col. 1, lines 10-30 and col. 2, lines 41-47).

It would have been obvious at the time to a person of ordinary skill in the art to modify the hand-held device disclosed by Nemirofsky, Bullock, and Jernigan to resemble a snap-shot camera, as taught by Boggs, for the benefit of providing a familiar camera-like structure for using the hand-held device in an entertaining way.

11. Claims 131 and 132 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lappington et al. (5,764,275) [Lappington] in view of Nemirofsky.

Regarding claim 131, Lappington discloses a method of interactive advertising and promotion on a display device during presentation of a special program (col. 5 line 60 – col. 6 line 64), wherein the special program is special event or game of skill (col. 8 line 66 – col. 9 line 12), the method comprising:

transmitting auxiliary data within a video signal during transmission of the special program to the display device (col. 6, lines 29-50);

wherein the auxiliary data is associated with sponsors of the special program (col. 9 line 66 – col. 10 line 4) and the auxiliary data is modulated within the video signal (col. 6, lines 29-40);

receiving the auxiliary data from the display device on a hand held device while the user of the hand held device views the special program on the display device (col. 6, lines 51-64);

processing and storing the auxiliary data on the hand held device to enable a user of the hand held device to play along with the special program (col. 6, lines 51-64); and

playing along with the special even at home by use of the hand held device (col. 6, lines 51-64).

Lappington fails to disclose providing promotional opportunities to the users of the hand held device based on playing along with the special event at home by use of the hand held device, the promotional opportunity redeemable by use of the hand held device at a point of sale.

In an analogous art, Nemirofsky teaches providing promotional opportunities to the users (col. 7, lines 25-49) of a hand held device (figs. 5-8, col. 7, lines 50-62) based on interacting with a television program at home by use of the hand held device (col. 11, lines 29-42), the promotional opportunity redeemable by use of the hand held device at a point of sale (col. 11, lines 43-65), providing the benefit of providing immediate electronic, redeemable benefits to users (col. 5, lines 20-24 and col. 12, lines 26-32 and col. 15, lines 1-19).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Lappington to include providing promotional opportunities to the users of the hand held device based on playing

along with the special event at home by use of the hand held device, the promotional opportunity redeemable by use of the hand held device at a point of sale, as taught by Nemirofsky, for the benefit of rewarding users with immediate electronic, redeemable benefits, such as coupons for retail products.

Regarding claim 132, Lappington and Nemirofsky disclose the method of claim 131, wherein the auxiliary data is subliminally modulated within an active portion of the video signal (Nemirofsky, col. 11, lines 30-42).

Conclusion

12. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic D. Saltarelli whose telephone number is (571) 272-7302. The examiner can normally be reached on Monday - Friday 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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